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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/753,087	01/07/2004	Yoshio Iwasaki	89285.0005	5419

26021 7590 01/17/2006

HOGAN & HARTSON L.L.P.
500 S. GRAND AVENUE
SUITE 1900
LOS ANGELES, CA 90071-2611

EXAMINER

CHEN, VIVIAN

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 01/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/753,087

Applicant(s)

IWASAKI ET AL.

Examiner

Vivian Chen

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 09 December 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: DETAILED ADVISORY ACTION. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-20.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☒ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see DETAILED ADVISORY ACTION.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☒ Other: DETAILED ADVISORY ACTION.

Vivian Chen
Primary Examiner
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DETAILED ADVISORY ACTION

Response to Proposed Amendment

1. The proposed amendments will **NOT** be entered because they raise new issues that would require further consideration and/or search (e.g., new issues under 35 USC 112, second paragraph, in claim 17, etc.)

Claim Rejections - 35 USC § 103

2. The rejections under 35 U.S.C. 103(a) of claim 1; claims 4-8, 18-19 (as dependent on independent claims 1, 9, 20); claims 12-13 (as dependent on independent claims 1, 9, 15, 20); claims 9-11; claim 14; claim 20 has been withdrawn in view of Applicant's arguments filed 12/9/2005. The Declaration filed 12/9/2005 has been considered.
3. Claim 15 and claims 4-8, 16-18 (as dependent on independent claim 15) remain rejected under 35 U.S.C. 103(a) for the reasons stated in the previous Office Action.

Response to Arguments

4. Applicant's arguments filed 12/9/2005 have been fully considered but they are not persuasive.

(A) Applicant argues that claim 16 has support in the specification as originally filed. However, Applicant fails to point out with specificity any portion of the specification supporting the claim language at issue.

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(B) Applicant argues that a terminal disclaimer is not required because claims 1-14, 20 have the same priority date as copending Application '352. However, since the unjustified or improper timewise extension of the "right to exclude" granted by a patent is not the sole reason for nonstatutory double patenting rejections (e.g., to also prevent possible harassment by multiple assignees) a double patenting issue still exists even when the claims share the same priority date; therefore a terminal disclaimer is required to overcome the outstanding double patenting rejection.

(C) Applicant argues that there is no double patenting issue with respect to claims 15-19 because the presently claimed invention is non-obvious since BAETZOLD fails to explicitly teach or disclose the recited MFR range. Applicant further argues that the specification provides evidence of unexpected results based on the recited MFR values. However, while the claimed invention may display improved performance and processibility in the recited MFR range, the showing is not commensurate in scope with the claimed invention (e.g., with respect to differing adhesive compositions such as differing amounts and types of EVA and/or tackifiers, etc.)

(D) In response to applicant's argument that there is no suggestion to combine BAETZOLD with copending Application '352, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Since the copending Application discloses a sealant layer composed of ethylene-vinyl acetate and a tackifying resin, it would be obvious to

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one of ordinary skill in the art to use known adhesive compositions satisfying this compositional requirement (e.g., those disclosed in BAETZOLD) which have a broad range of adhesive characteristics which allows it to be readily tailored or selected to obtain the desired bonding and removal characteristics recited in the copending Application claims, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In *re Leshin*, 125 USPQ 416. Applicant has not provided probative evidence of unexpected results or criticality from the recited MFR values which is commensurate in scope with the present claims.

(E) With respect to the rejection under 35 USC 103(a) of claim 15 and claims 4-8, 16-18 (as dependent on independent claim 15), Applicant argues that there is no suggestion to combine BAETZOLD with JUNKER because BAETZOLD does not explicitly discuss the use of the disclosed adhesive on display strips. In response to applicant's argument that there is no suggestion to combine BAETZOLD with JUNKER, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). The reference clearly discloses sealing compositions whose bonding strength can be tailored to a wide variety of bonding applications, and the list of possible applications is merely illustrative and not deemed to be limiting or precluding other known types of adhesive applications. Therefore, in lieu of any clear evidence or teaching to the contrary, it would be obvious to one of ordinary skill in the art to use known

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adhesive compositions having a broad range of adhesive characteristics, ready applicability to a variety of substrate, good non-blocking characteristics, and other desirable features (e.g., those disclosed in BAETZOLD) which allows it to be readily tailored or selected to obtain bonding and removal characteristics deemed desirable for specific usage conditions, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416. Applicant has not provided probative evidence of unexpected results or criticality from the recited MFR values which is commensurate in scope with the present claims.

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Conclusion

1. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivian Chen whose telephone number is (571) 272-1506. The examiner can normally be reached on Monday through Thursday from 8:30 AM to 6 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney, can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

The General Information telephone number for Technology Center 1700 is (571) 272-1700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

January 5, 2006



Vivian Chen
Primary Examiner
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